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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,414	09/30/2005	Keiichi Kawagoe	Q90666	4000
65565	7590	09/16/2010		
SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213			EXAMINER ANDERSON, REBECCA L	
			ART UNIT	PAPER NUMBER
			1626	
			NOTIFICATION DATE	DELIVERY MODE
			09/16/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SUGHRUE265550@SUGHRUE.COM  
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PPROCESSING@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,414	<b>Applicant(s)</b> KAWAGOE ET AL.	
	<b>Examiner</b> REBECCA L. ANDERSON	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 10, 14, 28 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 10 and 14 is/are rejected.
- 7) ☒ Claim(s) 1, 10, 14 and 32-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/9/10</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1, 10, 14, 28 and 32-35 are currently pending in the instant application. Claims 1, 10 and 14 are rejected. Claims 1, 10, 14 and 32-34 are objected. Claims 28 and 35 are withdrawn from consideration as being for non-elected subject matter.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 June 2010 has been entered.

#### ***Response to Amendment and Arguments***

Applicants' amendment and arguments filed 21 June 2010 has been considered and entered into the instant application.

Applicants' amendment to the claims has overcome the 35 USC 102(b) rejection over Graziani (abstract).

In regards to the claim objections, as the claims are still rejected under 35 USC 102(b), the objection is maintained as the claims still include withdrawn subject matter.

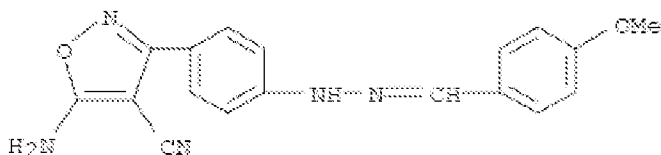
#### ***Election/Restrictions***

Applicant's election without traverse of Group I and the further election of the compound (4-pyridinecarboxyaldehyde 4-(oxazole-5-yl)phenylhydrazone) in the reply filed on 8 July 2008 has been previously acknowledged.

As per MPEP 803.02, the examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species is considered allowable and Applicant has overcome the previous 35 USC 102(b) rejections. Therefore, according to MPEP 803.02:

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable \*\*, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. the elected species shall be rejected, and claims to the nonelected species will be held withdrawn from further consideration.

As the elected species has been found allowable, the examiner has expanded the search and examination to the following compound:



**Claims 1, 10, 14 and 32-34 have been examined to the extent that they are readable on the elected embodiment, the elected species and the additional species indicated above.** Since the elected embodiment is not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration. Claims 28 and 35 are therefore withdrawn from consideration as being for non-elected subject matter. It has been determined that the entire scope claimed is not patentable.

### ***Claim Objections***

Claims 1, 10, 14, 32 and 33 are objected to as containing non-elected subject matter. Claims 1, 6, 10, 14, 32 and 33 presented drawn solely to the elected embodiment would overcome this objection.

### ***Allowable Subject Matter***

Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

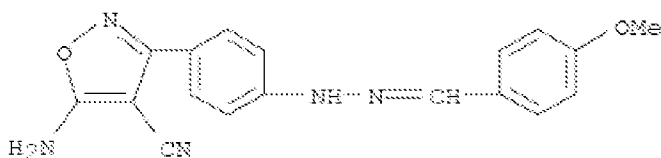
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Willitzer et al., DD 152786.

Willitzer et al. discloses the compound:



on page 3, table 1 wherein R1 is H

and R2 is p-CH<sub>3</sub>-O-C<sub>6</sub>H<sub>5</sub>-CH=N-, see the first table in the reference. Administration data in ml/L is also disclosed. Please note that the intended use in claim 14 does not

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render a known or obvious composition patentable, see *In re Tuominen*, 213 USPQ 89 (CCPA 1982). Additionally, a recitation of the intended utility in the preamble does not impart patentability to a known composition. *In re Spada*, 911 F.2d 705, 15 USPQ.2d 1655 (Fed. Cir. 1990). The compound in Willitzer corresponds to applicants instantly claimed invention wherein R1 is H; R2 is phenyl substituted with one Group (A); wherein Group (A) is alkoxy; R3 is H; Ar is phenylene; X is a single bond; and G is oxazole substituted with two group (C) substituents wherein group (C) is cyano and amino.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/  
Primary Examiner, AU 1626*

10 September 2010

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Rebecca Anderson  
Primary Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600